

**REMARKS**

Applicant respectfully requests reconsideration of the instant application on the basis of newly amended Claims 1 and 14. Claims 1 and 14 are the main claims and the remaining claims are directly or indirectly dependent upon those.

The Examiner has rejected the claims as being unpatentable over U.S. Patent No. 4,839,064 by McBurney et al. (*McBurney*) and U.S. Patent No. 1,561,744 by Raymond (*Raymond*). It is believed that Claims 1 to 18 are clearly distinguishable over these 2 references for the reasons that will be set forth.

Support for the amendment of Claims 1 and 14 is found in now canceled claims 10 and 16.

**35 U.S.C. § 102(b) Grounds for Rejection**

The Examiner has principally rejected the claims as being anticipated by *McBurney* and by *Raymond*. It is believed that Claims 1 to 18 are now clearly distinguishable over these references for the reasons that will be set forth.

Independent Claim 1 recites the following elements, the most pertinent to this discussion being presented in bold type for the convenience of the Examiner:

1. (Currently Amended)      A separation apparatus for separating solids from a slurry of liquid and solids of the type found in sewers, ponds, and tanks, comprising:

a separation tank **mounted on a mobile carrier**;  
an intake assembly means for communicating with the separation tank for conveying the slurry through an entrance end into an inlet formed in the tank;

an outlet system assembly means communicating with the separation tank for conveying decanted liquid in an outlet fluid flow line through an outlet formed in the tank to an exit end positioned in a desired location;

a pump means mounted in the fluid outlet flow line adapted for conveying the decanted liquid from the separation tank and through the outlet system; and

the tank, intake assembly, and outlet assembly form an airtight, compartmented system when the entrance end of the intake assembly and the exit end of the outlet assembly are sealed.

Since such mounting of the separation tank of the Applicant's invention as claimed is not disclosed or suggested by *McBurney*, Applicant suggests that the claimed structure of the present invention is neither identical to or disclosed by either of the two devices. Therefore, *McBurney* and *Raymond* cannot anticipate the present claimed invention.

Even if either the *McBurney* or *Raymond* patents incidentally showed a similar arrangement of parts, if that arrangement is neither claimed nor designed to perform the function of the present invention, neither patent can act as an anticipation.

### **35 U.S.C. § 103 Grounds for Rejection**

The Examiner has also rejected now cancelled Claims 10 and 16 (now amended claims 1 and 10) under 35 U.S.C. § 103(a) as being unpatentable over *McBurney* in view of *Raymond*. Applicant respectfully traverses these rejections for the reasons discussed below.

Applicant's invention is directed toward solving the disadvantage that mounting a pump ahead of the separation container, such as U.S. Patent No. 5,336,333 to Sheppard et al. (*Sheppard*), may lead to excessive wear of the pump. Furthermore, when the separation tank is

filled with sediment, the prior tank was difficult to empty or transport for removal of the waste sediment.

By this structure Applicant is able to achieve the advantages which have hitherto not been able to be achieved through any adaption of the prior art. It is therefore believed to be clear that the particular structure of Applicant is extremely important and is not a mere matter of design. It should also be noted that (1) the *Raymond* reference has been available since November 17, 1925; (2) the *McBurney* reference has been available since June 13, 1989; and (3) the *Sheppard* reference has been available since August 9, 1994. Between as late as August 1994 and the present, no-one except Applicant has constructed separation apparatus for separating solids from a slurry of liquid and solids of the type found in sewers, ponds, and tanks without the disadvantages discussed above and which are clearly set forth on the first few pages of Applicant's specification. It is certainly believed to be pertinent that no-one has achieved or anticipated Applicant's structure despite the availability of the reference.

It is improper to use hindsight having read the Applicant's disclosure to "pick and choose" among isolated prior art references to disparage the claimed invention. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Even where an invention is, as a whole, fully disclosed by a combination of prior art elements, such elements cannot be combined to defeat a patent as obvious unless the art teaches or suggests the desirability of making the combination. ASC Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. 929 (Fed. Cir. 1984). Thus, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, U.S.P.Q.2d 1780 (Fed. Cir. 1992). Finally, it is the invention as a whole that is important. Focusing on the obviousness of substitutions and

differences, instead of on the invention as a whole, is a legally improper way to simplify the often difficult determination of obviousness. Gillette Co. v. S. C Johnson & Son, Inc., 919 F. 2d 720, 16 U.S.P.Q. 1923 (Fed. Cir. 1990).

To the extent that this rejection is maintained by the Examiner, Applicant respectfully requests that the Examiner specifically identify the reference or knowledge upon which such a continuing rejection is maintained. To the extent that the rejection is based on any personal knowledge of the Examiner, Applicant respectfully requests an affidavit in accordance with 37 C.F.R. § 1.107.

Dependent Claims 2-13 and 15-18 that depend from independent Claim 1 or 14 are also not made obvious by *McBurney* in view of *Raymond* because they include the limitations of Claims 1 or 14 and add additional elements that further distinguish the art. Therefore, Applicant respectfully requests that Claims 1-18 be allowed.

### Conclusion

Applicant has now made an earnest attempt to place this case in condition for allowance. In light of the amendments and remarks set forth above, Applicant respectfully requests reconsideration and allowance of Claims 1-18.

If there are matters which can be discussed by telephone to further the prosecution of this Application, Applicant invites the Examiner to call the attorney at the number listed below at the Examiner's convenience.

Respectfully submitted,



Thomas F. Marsteller, Jr.  
Registration No. 29,672

Marsteller & Associates, P.C.  
PO Box 803302  
Dallas, TX 75380-3302  
(972) 233-0939  
(972) 386-3907 (Fax)

Date: January 15, 2004

**ATTACHMENT A**

**LISTING OF CLAIMS WITH MARKINGS  
TO SHOW CHANGES MADE**

Attachment A  
Listing with Markings  
8

**Amendments to the Claims:**

This listing of claims will replace all prior versions and listings of claims in the application:

**Listing of Claims:**

1. (Currently Amended) A separation apparatus for separating solids from a slurry of liquid and solids of the type found in sewers, ponds, and tanks, comprising:

a separation tank mounted on a mobile carrier;

an intake assembly means for communicating with the separation tank for conveying the slurry through an entrance end into an inlet formed in the tank;

an outlet system assembly means communicating with the separation tank for conveying decanted liquid in an outlet fluid flow line through an outlet formed in the tank to an exit end positioned in a desired location;

a pump means mounted in the fluid outlet flow line adapted for conveying the decanted liquid from the separation tank and through the outlet system; and

the tank, intake assembly, and outlet assembly form an airtight, compartmented system when the entrance end of the intake assembly and the exit end of the outlet assembly are sealed.

2. (Original) The invention of claim 1 wherein the pump is a centrifugal pump.

3. (Original) The invention of claim 1 wherein the pump is hydraulic.

4. (Original) The invention of claim 1 wherein the pump is pneumatic.

5. (Original) The invention of claim 1 wherein the intake assembly further includes an intake pump means for conveying the slurry.

6. (Original) The invention of claim 1 wherein the intake assembly includes a hose.

Attachment A  
Listing with Markings

7. (Original) The invention of claim 1 wherein the outlet assembly includes a hose.
8. (Original) The invention of claim 1 wherein the intake assembly includes a flow control valve.
9. (Original) The invention of claim 1 wherein the outlet assembly includes a flow control valve.
10. (Cancelled)
11. (Original) The invention of claim 1 wherein the intake assembly siphons slurry from a sewer.
12. (Original) The invention of claim 1 where the intake and outlet assemblies are removable from the separation tank.
13. (Original) The invention of claim 1 where the intake and outlet assemblies, and the separation tank form a sealed unit.
14. (Currently Amended) A method for cleaning a source of slurry composed of liquid and solids utilizing an intake assembly for conveying the slurry into a separation tank, comprising the steps of:  
  
placing an entrance end of the intake assembly into the source of slurry to be separated;  
conveying the slurry into the separation tank through the intake assembly;  
separating solids from the slurry in the separation tank mounted on a mobile carrier by settling the solids from the liquid;  
extracting decanted liquid from the separation tank;

Attachment A  
Listing with Markings  
10

pumping the decanted liquid through a pump located in the flow path of the liquid through the outlet assembly in fluid flow communication with the separation tank; and releasing the decanted water through an exit end of the outlet assembly at a desired location.

15. (Original) The method of claim 14 wherein the pump is a centrifugal pump.

16. (Canceled)

17. (Original) The method of claim 14 wherein the intake and outlet assemblies are removable from the separation tank.

18. (Original) The method of claim 14 wherein the intake assembly further includes an intake

Attachment A  
Listing with Markings  
11